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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/884,873 06/30/97 COOK

F ISIS-2202

HM12/0105

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EXAMINER

RICIGLIANO, J

ART UNIT

PAPER NUMBER

1618

DATE MAILED: 01/05/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

08/884,873

Applicant(s)

Cook, Philip Dan

Examiner

Joseph W. Ricigliano Ph. D.

Group Art Unit

1618



☒ Responsive to communication(s) filed on Oct 6, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 2-19, 24-30, and 32 is/are pending in the application.

Of the above, claim(s) 27-30 is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 2-19, 24-26, and 32 are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1618

## DETAILED ACTION

### *Continued Prosecution Application*

1. The request filed on 10/6/99 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/884,873 is acceptable and a CPA has been established. An action on the CPA follows.

### *Status of the claims*

Claims 2-19, 24-30 and 32 are pending in the instant application. Claims 27-30 stand withdrawn from consideration as being drawn to a nonelected invention. Claims 2-19, 24-26 and 32, drawn to the invention of group I are being examined on their merits.

### *Election/Restriction*

**Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Donald E. Adams, Ph.D., Supervisory Patent Examiner at [Donald.Adams@uspto.gov](mailto:Donald.Adams@uspto.gov) or 703-308-0570. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

2. Group I of this application contains claims directed to patentably distinct species of the claimed invention.

Claim 32 is generic to a plurality of disclosed patentably distinct species comprising diverse mixtures of six or more compounds. Applicant election of species should set forth the six chemical compounds comprising the mixture indicating the structure of all six compounds setting forth all groups. In order to proceed with more compact prosecution and to eliminate possible problems with chemical nomenclature applicants are requested to provide the structures of the six

Art Unit: 1618

compound in the species of mixture elected. The species are distinct since each contains different compounds.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed.

3. Currently 32 is generic to the invention of group I.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Art Unit: 1618

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).


Applicant is also reminded that a 1 - month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph W. Ricigliano Ph. D. whose telephone number is (703) 308-9346. The examiner can be reached on Monday through Thursday from 7:00 A.M. to 5:30 P.M.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the group receptionist whose telephone number is (703) 308-0196.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald E. Adams Ph. D., can be reached at (703) 308-0570.

Joseph W. Ricigliano Ph. D.

  
DONALD E. ADAMS  
SUPERVISORY PATENT EXAMINER